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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/542,528	10/28/2005	Takashi Yamaguchi	09867/0203136-US0	7134
7278 7590 09/03/2009 DARBY & DARBY P.C. P.O. BOX 770 Church Street Station New York, NY 10008-0770				
EXAMINER HARPER, TRAMAR YONG				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
09/03/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/542,528

**Applicant(s)**

YAMAGUCHI ET AL.

**Examiner**

TRAMAR HARPER

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date 10/12/05, 05/27/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. No where within the specification does it explicitly disclose the "extension unit provided in a remote-control toy". The examiner contends that the applicant intended for the remote-control toy to mean an overall system. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freifeld (US 7,072,792) in view of Ishimoto (US 5,088,955).**

**Claims 1-3:** Freifeld discloses a remote control toy system comprising radio controlled cars. There is at least one controller that transmits control signals containing operation signals based on user input to a driving device or remote control car. The system

further comprises an extension unit or scoreboard for receiving signals transmitted from the remote control cars. Each remote control car sending a different radio frequency signal in which the processor of the extension unit discriminates between the signals and outputs a unique audio corresponding to the specific car. The invention comprises r/c cars passing at least one gate and as the car passes the gate the car transmits such an event to the scoreboard, wherein the scoreboard updates and displays various information of the specific car involved in the race. The extension unit or scoreboard includes a unit main body (22), a processor including signal processing (56), and a signal receiver (54). In summary the system is set such that when each car passes the at least one gate a unique frequency from each car is transmitted to the extension unit, wherein the extension unit as a result outputs a corresponding unique sound based on the received signal via a speaker (58) (Col. 2:60-68, Col. 3:3-10, Col. 4:10-23, 40-45, 60-68, Col. 5:54-61, Col. 6:40-49, 61-67, Col. 7:1-6, Col. 8:30-39, 54-60, Col. 9:25-43, Figs. 1-2, 7, & 10-11).

Freifeld disclose the above, but excludes playing various sounds via the extension based on various received control signals of the respective cars. It is well known in the art that control signals are received from the remote controller to the respective vehicle via unique frequencies. In an analogous art of Ishimoto teaches a remote control car system comprising at least one remote controlled vehicle and a controller. The controller sends control signals via radio frequency and the vehicle discriminates or determines which control signal is being sent and based on such outputs via a speaker the corresponding sound. For example, if a user inputs a reverse

control signal then a brake sound is outputted. Such an invention adds to the realism of the toy device therefore increasing overall enjoyment of the device (Ishimoto Col. 1:48-55, Col. 2:1-22, 65-68, Col. 3:1-8, 39-41, Figs. 1-5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the system of Freifeld such that the extension unit or scoreboard discriminated between control signals of the respective cars and outputted the corresponding sound, as taught by Ishimoto, to provide a more entertaining remote control toy system. Freifeld already teaches outputting unique sounds based on received frequencies from the r/c cars in attempts to add to the realism of the system (Col. 6:60-Col. 7:5). Therefore, modifying the system to achieve the above would be well within the realm of an artisan skilled in the art.

Freifeld in view of Ishimoto discloses the above, but excludes the signal processing device detachable from the extension unit, the signal processing device being separate from the processing device of the extension unit, or a terminal and connecting portion. However, applicant fails to disclose that having the signal processing device detachable from the extension unit, the signal processing device being separate from the processing device of the extension unit, or a terminal and connecting portion. Moreover, it appears that the processing device of Freifeld in view of Ishimoto, or applicant's invention, would perform the same function of providing an system from discriminating between output/control signals of respective cars and outputting corresponding sounds of such signal. Therefore, it would have been prima facie obvious to modify Freifeld in view of Ishimoto to obtain the invention as specified in

claims 1 and 3 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Freifeld in view of Ishimoto.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Wolf (US 2003/0001051 A1) discloses adding additional storage or memory to provide additional sound profiles to the remote control toy train system.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRAMAR HARPER whose telephone number is (571)272-6177. The examiner can normally be reached on 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ronald Laneau/  
Primary Examiner  
Art Unit 3714

TH

08/14/09